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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/550,834

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Marcel Vos

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1758

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GOODWIN PROCTER L.L.P
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EXAMINER

OJURONGBE, OLATUNDE S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

08/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/550,834	Applicant(s) VOS ET AL.	
	Examiner OLATUNDE S. OJURONGBE	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20060117, 20050923</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. **Claims 1-52** are objected to because of the following informalities:

In claim 1, it is unclear whether $L-(NR_6-L)_p$ is one of the options for L' as the comma in between NR_6 and $L-(NR_6-L)_p$ separates $L-(NR_6-L)_p$ from other options listed for L' .

Claim 1 cites R_1 , R_2 , R_4 and R_5 in (III) are defined as $-O-Z(O)-R_8$, where R_8 is defined "as is R_7 below", instead of "as in R_7 below", the claim further cites "optionally substituted with on or more substituents" instead of "optionally substituted with one of more substituents".

Claim 34 cites the limitation "wherein each R_4 and R_5 may be hydroxyl or may be independently selected from.....or R_4 or R_5 may independently be an $-O-C(O)-L$ -group", the use of "may be/ may" in this claim makes the claim unclear, for clarity purposes, "may be/ may" should be changed to "is".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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3. **Claims 1-21, 23-47 and 51-52** are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the preparation of the poly(silyl ester)s, wherein L is a hydrocarbyl or substituted hydrocarbyl group, wherein said substituents is independently selected from the group consisting of alkyl, cycloalkyl, carboxy, substituted carboxy, alkoxyl, aralkyl, aralkyloxy, aryl, aryloxy, hydroxyl, halogen, amino and amino alkyl radical, it does not reasonably provide enablement for the preparation of the poly(silyl ester)s, when L is any known polymer which can be any of hundreds of thousands of possibilities. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to produce and use the invention commensurate in scope with these claims, because it is beyond routine experimentation to determine which polymers and their combinations will work in the invention and which ones will not.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1-9, 11-46 and 48-52** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following errors make claim 1 with its dependent claims unclear:

A) Z is undefined in claim 1;

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B) claims 1, 7 and 11 cite improper Markush limitations, using the term “comprising” instead of “consisting”.

C) R_1 , R_2 , R_4 and R_5 for formula (III) are defined by two different terms on page 4 of the listing of claims, one term refers to the values above, whereas the other term defines R_1 , R_2 , R_4 and R_5 as $-O-Z(O)-R_8$.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLATUNDE S. OJURONGBE whose telephone number is (571)270-3876. The examiner can normally be reached on Monday-Thursday, 7.15am-4.45pm, EST time, Alt Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571)272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

O.S.O.

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796